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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/273,149	03/19/1999	KEVIN M. PINTAR	22074661-255	6715

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BAKER & MCKENZIE
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NEW YORK, NY 10022

EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

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DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/273,149

Applicant(s)

PINTAR ET AL.

Examiner

CESAR B PAULA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the IDS, and request for reconsideration filed on 2/3, and 2/10/2003.

This action is made Final.

2. Claims 1-20 are pending in the case. Claims 1, 8, and 15 are independent claims.

Information Disclosure Statement

3. The information disclosure statement filed 2/3/2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language (EP 0 764 899 A1 Ahlers et al). It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-6, 8-12, 15-18, and 20 remain rejected under 35 U.S.C. 102(a) as being anticipated by Devanbu (Pat.# 5,826,256, 10/20/98).

Regarding independent claim 1, Devanbu discloses the conversion of an input source parse tree into a second output parse tree by generating optimized translation or conversion routines at runtime -- (c.6, L.1-67,).

Moreover, Devanbu discloses the reception of an input specification description for an input dependent parse tree 311 in a first computer language, and specification of the attributes of a target output parse tree 101 (c.6, L.1-67, abst.).

Furthermore, Devanbu discloses the generation of optimized translation or conversion routines at runtime, and converting the parse tree 311 -- (c.6, L.1-67, abst.).

Claims 2-6 is directed towards a method for performing the steps of claim 1, and are therefore similarly rejected.

Claims 8-12 are directed towards a method for performing the steps of claims 3, 2, 4, 6, and are therefore similarly rejected.

Claims 15-18, and 20 are directed towards a computer system for implementing the steps found in claims 1-4, and 6 respectively, and are similarly rejected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2178

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devanbu, in view of KUWAHARA (Pat. # 6,202,072, 3/13/2001, filed on 12/5/1997).

Regarding claim 13, which depends on claim 8, Devanbu discloses the conversion of an input source parse tree into a second output parse tree by generating optimized translation or conversion routines at runtime -- (c.6, L.1-67). Devanbu fails to explicitly disclose *input and output attribute are date type*. KUWAHARA discloses: "The SGML conversion form generation module 101 generates a SGML conversion form file... Three types of information, as shown in Fig. 2, such as a prototype of a plain text document, document type definition... is required for preparation of a SGML conversion form" (Col. 5, lines 25-67, Col. 7, lines 26-67, and Fig. 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Devanbu, and Kuwahara, because KUWAHARA teaches above, invoking a program for the dynamic conversion of an input prototype document into the SGML document, which has a "date" attribute in output field "b".

Claim 19 is directed towards a computer system for implementing the steps found in claim 13, and therefore is similarly rejected.

9. Claims 7, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devanbu, in view of Mcallum (Pat. # 5,784,635, 7/21/98).

Regarding claim 7, which depends on claim 1, Devanbu discloses the conversion of an input source parse tree into a second output parse tree by generating optimized translation or conversion routines at runtime -- (c.6, L.1-67). Devanbu fails to explicitly teach *generating*

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program debugging instrumentation. Mcallum discloses: “This updating process, thus, not only corrects keying errors and standardizes syntax” (Col. 5, lines 35-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to have debugged the routine, because Mcallum teaches above, the generation of cleaning routines for correcting error syntax rules.

Claim 14 is directed towards a computer system for implementing the steps found in claim 7, and is similarly rejected.

Response to Arguments

10. Applicant's arguments filed on 2/10/2003 have been fully considered but they are not persuasive. The Applicants indicate that Devanbu does not teach receiving a first attribute of a first input field and a second attribute of a second output field type, and Devanbu contains no mention the conversion of input field types to output field type (p.2,L.7-16). The Examiner disagrees, because Devanbu teaches the input of a parse tree, and a description containing statement types or attributes of a node input field type, and the input of node type declaration or attribute for describing a node output field type of an output parse tree (c.6,L.11-67).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “Devanbu does not disclose or suggest “dynamically creating at runtime a plurality of data field conversion routines for each set of input attributes and output attributes” p.2,L.17-19) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). Claim 1 only recites the dynamic creation at runtime of a first optimized conversion routine for one set of input/output attributes (L.6-9).

Regarding claims 7, 13, 14, and 19, the Applicants indicate that Devanbu does not teach or suggest the limitations of these claims, because Devanbu does not teach or suggest the limitations of claim 1 as described above. As the Examiner explained above, Devanbu teaches every limitation of claim 1. Therefore these claims stand rejected based at least on the rejection of claim 1.

Conclusion

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Allen et al. (Pat. # 6,502,236).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry, **except formal After Final communications**)

Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label **"PROPOSED"** or **"DRAFT"**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,

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Arlington, VA, Sixth Floor (Receptionist).

CBP

4/3/03

[Signature]
Primary Examiner